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#### REMARKS

This Amendment is submitted in response to the Office Action mailed on April 29, 2009. Claims 1 - 5, 17, 18, 20 - 24, and 26 - 32 are pending, and all stand rejected at present. Dependent claims 33 and 34 are added. No fee is due.

Amendments are believed to remove the bases for the 112 - rejections.

Support for the amendments to the claims is found in the Specification as follows:

#### Location of Support

Page 10, line 16 - page 11, line 2;  
page 12, lines 12 - 17; and  
page 14, line 21 - page 15, line 21;

Page 4, lines 11 - 22.

#### RESPONSE TO 103 - REJECTIONS

All claims were rejected as obvious, based on Suer.

#### SUMMARY OF SELECTED POINTS

##### Point 1

Summary: it is **impossible** for Suer to show some of the independent claims. If Suer is constrained to communicate with a **single** "mobile portal," that means that Suer's ATM has a **single** customer.

In general, some cell phones can

- 1) receive data from "mobile portals" (a

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term-of-art) and

2) display the data on their small screens.

A "mobile portal" is not necessarily "mobile," but it acts as a web site for mobile devices, such as cell phones.

Under the invention, an ATM (not a cell phone) retrieves data from a "mobile portal," via a wireless connection, and displays it in a small window on the ATM's larger display.

Independent claims 26 and 29, and dependent claim 19, state that the ATM is constrained to communicate with a **single** "mobile portal."

The Office Action relies on a portable electronic wallet, used by an individual in Suer, to show the claimed "mobile portal." Suer's wallet communicates with an ATM, and assists the customer in ATM transactions.

However, as stated above, the cited independent claims state that the ATM is constrained to communicate with a **single** "mobile portal."

That is **impossible** in Suer. If Suer shows that aspect of the claims, then Suer's ATM has a **single** customer (the one owning the wallet), and no others.

## Point 2

Claims 1, 33 and 34, state that the "information" received from the "portal" is retrieved from a WAP **web site which is**

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**accessible to cell phones.** To repeat: (1) the "information" is retrieved from a "web site," and (2) the web site is accessible to cell phones.

Suer's portable wallet does not qualify as such.

### **Point 3**

All three independent claims (1, 26, and 29) state that an ATM receives information in a format which is compatible with the screen size of a cell phone.

The Office Action admits that Suer does not show this. To overcome the absence, the Office Action asserts that such formatting is well known in cell phones, and that it is obvious to apply such formatting to ATMs.

However, Applicant points out that ATMs and cell phones are non-analogous arts. The Office Action cites something that is "well known" in cell phones, and asserts that it is obvious to apply that thing to ATMs. Under the patent rules, that is invalid reasoning.

Stated more simply: something in an art which is non-analogous to an ATM cannot be "obvious" to an ATM-invention.

### **Point 4**

As Point 3 explained, the Office Action asserts that the claimed "format" of data is not found in Suer, but is well known.

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However, that well known data format is found in the world of cell phones. No cell phone has been cited in Suer. And no cell phone has been combined with anything else to attain the claimed invention.

Thus, no connection has been shown which links the supposedly well known format with the claimed invention.

#### **Point 5**

To repeat: as Point 3 explained, the Office Action asserts that the claimed "format" of data is not found in Suer, but is well known.

However, the only possible entity in Suer to which that "format" is relevant is the portable wallet, which is used by the customer. The reason is that this wallet has a small display.

Thus, if the well known "format" is to be combined with Suer, it should be combined with the portable wallet, not with Suer's ATM. That would be the logical combination, if a combination is warranted. That combination does not lead to the claimed invention.

To repeat: any combination must be logical. The only logical possibility is to combine the "well known" format with Suer's wallet. But that does not produce the claimed invention.

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#### **Point 6**

Claim 1 states that

-- the "information" is retrieved from a  
"mobile portal;"

-- the information is in "a format compatible  
with screen size of a cellular telephone."

As explained above, Suer's portable wallet is treated as the  
"mobile portal."

Applicant points out that there is no reason whatever for  
Suer's portable wallet to transform the data which it transmits  
into the claimed format. The claimed format applies to cell  
phones. No cell phone has been cited in Suer.

Further, the claimed format only applies to small displays.  
Suer's portable device is transmitting to an ATM, which has a  
relatively gigantic display.

#### **Point 7**

The discussion below sets forth additional points.

Not all points outlined above are elaborated in the following  
discussion, because some are considered self-explanatory.

**END SUMMARY**

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## DETAILED RESPONSE TO 103 - REJECTIONS

### ONE FORM OF INVENTION

#### Summary

Cell phones can obtain data using a "WAP" protocol. Under this protocol, the cell phone displays the data as a few lines of text, in order to fit into the small display of the cell phone.

One form of the invention displays the data in a window created in a larger display, such as the display screen of an ATM.

Thus, a cell phone owner, who is using an ATM at the moment, sees a display on the ATM which is familiar.

#### Detailed Description of Invention

Under the invention, an ATM (Automated Teller Machine) is connected to **two remote entities**:

- 1) a central computer, termed an "authorization center," which authorizes ATM transactions, and
- 2) a "mobile portal."

"Mobile Portal" is a term-of-art, and refers to a "portal" (or entry point) used by "mobile" devices, such as cell phones, to reach a network or, more specifically, a computer within the network.

Under some claims, the ATM connects to the mobile portal wirelessly.

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Therefore, the claimed ATM

- 1) connects to an authorization center (which is commonly done using a private telephone network), and
- 2) connects to a mobile portal **wirelessly**.

Because of space limitations in the displays of cell phones, when cell phones retrieve information from a mobile portal, that information is displayed in only a few lines of text, such as three to five lines. (Specification, page 13, lines 6 - 8.)

Under the invention, the ATM displays these few lines of text, on its much larger display.

The information can be transmitted using the WAP, Wireless Application Protocol, as opposed to standard internet protocol. The WAP has a limitation: a WAP browser (on a cell phone, for example) can only display three to five lines at a time. (Specification, page 13, lines 4 - 12.)

#### RESPONSE TO SELECTED INDIVIDUAL REJECTIONS

##### Claim 1

##### Point 1

A specific claim element has not been shown in the prior art.

Claim 1, prior to current amendments, recited:

. . . means for presenting at least some of the **retrieved information** to a user on the

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display of the ATM . . .

According to the claim, the recited "retrieved information" has specific characteristics:

- the "information" is retrieved from a "mobile portal;"
- the information is in "a format compatible with screen size of a cellular telephone."

The Office Action, page 3, admits that "Suer . . . [does] not explicitly state displaying the information in a format compatible with screen size of a cellular telephone."

Thus, this claim element (the "information" as defined in the claim) is missing from the reference.

To cure this defect, the Office Action then asserts that

- 1) it is well known that cell phones display information in such a format, and
- 2) it is obvious to "incorporate this well known feature in the ATM of Suer."

However, several problems exist in this assertion.

#### PROBLEM 1

The claimed "information," which is in "a format compatible with screen size of a cellular telephone," has not been shown in the prior art. The Office Action relies on Applicant's



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Specification, page 4, to show this element.

However, Applicant's Specification is not prior art. MPEP § 901.03 states:

#### Pending Applications

Except as provided in 37 CFR 1.11(b), pending U.S. applications are preserved in confidence (37 CFR 1.14(a)) and **are not available as references.**

MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

The claimed "information," which is displayed, has not been shown in the prior art.

#### PROBLEM 2

The claimed "mobile portal" has not been shown in Suer.

The Office Action, page 3, states that Suer shows a "means for receiving over a wireless channel information from [a] mobile portal **or device.**"

But the claim does not recite that.

The claim does not recite "mobile portal **OR** device."

The Office Action is re-writing Applicant's claims, which is not allowed. The Office Action has added a disjunctive to the

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claim language, namely, "or device."

Point 2

Claim 1 recites a "means for retrieving" information from a "mobile portal." As to a "means," section 112 states:

An element in a claim . . . may be expressed as a means . . . and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

As to the claimed "means," the Office Action has not shown the "corresponding" item in Suer, nor an "equivalent."

The claimed "means for retrieving" has not been shown in the prior art.

Point 3

Continuing Point 2, Applicant points out that the claim states that the "mobile portal" "transmits information in a format compatible with screen size of a cellular telephone."

The Office Action has **not shown** a "mobile portal" having such characteristics.

Consequently, the Office Action necessarily has not shown

-- a "means for retrieving" anything from  
such a (missing) "mobile portal,"  
nor

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-- such a "means" in an ATM.

Point 4

No teaching has been given for combining the "well known" element with Suer.

The rationale given, in essence, is that the combination provides convenient viewing of financial information. However, Suer, **by himself**, provides that "viewing."

Suer expressly states that his system allows a personal computer to display a person's financial information. (Column 6, lines 59 - 67.)

That personal computer does not use the claimed "mobile portal," nor a "a format compatible with screen size of a cellular telephone." (The Office Action admits the latter.)

Therefore, the rationale given for combining the "references" does not actually lead to the claimed invention. If you want to attain the goal set forth in the rationale (convenient viewing of financial information), you can merely follow Suer's teaching alone, and use his system.

You do not need, and the rationale does not lead to, the claimed invention.

Point 5

Certain recitations of **amended** claim 1 are not found in Suer.

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.

#### MISSING RECITATION 1

Amended claim 1 states that the ATM can connect to two different entities:

- an "authorization center" and
- a "mobile portal."

Such an ATM, with the two connections, has not been shown in Suer. (As explained herein, Suer's wallet does not qualify as the claimed "mobile portal.")

#### MISSING RECITATION 2

Claim 1 states that

- 1) the information is displayed in a window on the ATM,
- 2) the contents of the window change, while
- 3) the rest of the ATM display does not change.

That is not seen in Suer.

#### Point 6

The Office Action, in essence,

- 1) cites a "well known" approach, which displays a few lines of text on a cell phone, and then
- 2) asserts that it is obvious to perform that type of

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display on an ATM.

However, the reason for that approach is the small size of a cell phone display. An ATM display does not face that constraint.

Therefore, no reason has been given for not using the ATM's full display capacity.

#### Claim 19

Dependent claim 19 states that the ATM can connect with a **single** mobile portal, and no others.

That has not been shown in the prior art.

#### Claim 20

##### Point 1

Dependent claim 20 states that the "information," which is in a window, is removed after a set time.

Under the claim, and its parent, the following elements are present:

- 1) information in a window,
- 2) on an ATM display,
- 3) which information changes while the rest of the ATM display does not,
- and
- 4) the information is removed after a set time.

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Those elements are not found in Suer.

#### Point 2

Office Action admits that the recitations of claim 20 are not shown in Suer, but asserts that the recitations are obvious.

That approach fails to follow the law of obviousness.

The elements of every claim must be shown in the prior art, and then the question becomes whether it is "obvious" to combine them into the invention.

Missing elements cannot be "obvious."

#### Point 3

The rejection fails to follow the rules of Deere, as outlined in MPEP § 706.02(j):

#### Contents of a 35 U.S.C. 103 Rejection

. . . After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

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Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

#### Claim 26

The preceding discussion applies to claim 26.

Specifically, claim 26 states that

- 1) the ATM display displays information relating to ATM functions;
- 2) the ATM also displays information "compatible with the screen size of a cellular telephone" in a window which overlies the ATM display.

That has not been shown in Suer.

Claim 26 also states that the display in the window is limited in time. That has not been shown in Suer.

Claim 26 also states that the ATM gets the information from a single portal, and not others. That has not been shown in Suer.

#### Claim 27

The discussion of claim 20 applies to claim 27.

Office Action admits that the recitations of claim 27 are not shown in Suer, but asserts that the recitations are obvious.

That approach fails to follow the law of obviousness.

The elements of every claim must be shown in the prior art,

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and then the question becomes whether it is "obvious" to combine them into the invention.

Missing elements cannot be "obvious."

#### **Claim 29**

Claim 29 states that the ATM can reach a **single** "mobile portal" and no others.

That has not been shown in Suer.

Further, this recitation is contrary to the operation of Suer. The Office Action treats the portable device in Suer as the claimed "mobile portal." An ATM in Suer communicates with that "portal."

Plainly, the ATM in Suer must be able to communicate with numerous "portals," because the ATM must deal with numerous different customers.

Thus, Suer is directly contrary to claim 29, and teaches away from the claim.

#### **Remaining Claims**

The discussion above applies to the remaining claims.

#### **Added Claims 33 - 35**

These claims state that the information is retrieved from a WAP web site, which is accessible to cell phones. That is not seen in Suer.




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#### CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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